

REMARKS

Claims 1, 3-7, 10-13, 18, 20, 21, 23, 24, and 26-35 are pending in the application, claims 1, 3-7, 10 11, 13, 18, 20, 21, 23, 24, 26-28, and 30-35 are allowed, and claims 12 and 29 are rejected.

This is a full and timely response to the Office Action mailed July 21, 2006. Reexamination and reconsideration is requested in view of the following remarks. No new matter has been added as by way of this response.

I. Rejections under 35 U.S.C. 103

The Examiner rejects claims 12 and 29 under 35 U.S.C. 103(a) as being unpatentable over Klumb et al. (U.S. 5,935,124) and King (U.S. 4,282,886). Examiner states that Klumb discloses a medical lead 14 extending through the central lumen of catheter body 12 and a tip electrode 36 that includes an infusion tube 88 used to infuse fluids in proximity of the distal end of the tip electrode. Examiner states that while Klumb et al. does not specifically disclose that the fluid infused is a tissue adhesive, King discloses an epicardial lead utilizing a tissue adhesive 16 to securely affix the electrode. Examiner concludes that it would be obvious to one of ordinary skill in the art to modify the system of Klumb et al. in accordance with the teachings of King so as to infuse tissue adhesive to affix the electrode in its proper position in the body.

It is respectfully submitted that the rejection under 35 U.S.C. 103 based on Klumb et al. and King is improper for the reasons set forth below.

II. The Cited References Do Not Suggest the Desirability of Applicant's Invention

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Klumb et al. reference relates to an ablation catheter

having a tip electrode containing multiple temperature sensors at predetermined locations. Column 1 of Klumb et al. states "Ablation catheters typically have a tip electrode at their distal end for ablating the heart tissue". That is, ablation catheters are designed to destroy tissue. Therefore, it should be clear, that there would be no desire to secure the tip of the ablation catheter to, for example, heart tissue as is suggested by King.

It is well known that the mere fact that references can be combined or modified does not render the result in combination obvious unless the prior art also suggests the desirability of the combination. The requisite desirability of an ablation electrode glued to a patient's heart is clearly absent in the Klumb et al. reference.

III. The Proposed Modification would Render the Ablation Catheter of Klumb et al. Unsatisfactory for its Intended Purpose

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. A physician or other practitioner utilizing an ablation catheter to remove heart tissue or the like certainly needs the freedom to manipulate the ablation electrode to achieve the desired tissue destruction. To secure the electrode by means of an adhesive to the tissue being ablated would not provide a practitioner with the requisite freedom.

IV. Examiner's Conclusion of Obviousness is Based on Improper Hindsight

While it is true that any judgment of obviousness is in a sense necessarily a reconstruction based on the hindsight reasoning, the rejection is proper so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from Applicant's disclosure. In this case, however, there is absolutely no motivation, express or implied, to combine the references. Therefore, it is respectfully submitted that the Examiner is utilizing improper

hindsight. That is, there is no suggestion or motivation expressed in the Klumb et al. reference that the ablation lead be attached to a patient's tissue using an adhesive, nor is there any suggestion in the King reference that the epicardial lead disclosed be used in an ablation catheter.

In view of the above, it is respectfully submitted that claims 12 and 29 are not obvious over Klumb et al. in view of King and are believed allowable.

V. Allowed Claims

Allowance of claims 1, 3-7, 10, 11, 13, 18, 20, 21, 23, 24, 26-28, and 30-35 is hereby acknowledged.

VI. Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this Amendment, the Examiner is requested to telephone the undersigned attorney to attend to those matters.

Respectfully submitted,

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Date

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